

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 5-11 and 15-21 remain active in the application.

Claim Rejections Based on 35 U.S.C. §112

Claims 1-10 and 15-19 are rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 1 recites the limitation "an audio coder decoder." According to the Office Action, it is unclear if this is intended to mean a coder and decoder such as a codec. According to the Office Action, it is unclear what a "digital analog signal" is in claim 15. Claims 1 and 15 have been amended to overcome these rejections. Applicant respectfully requests withdrawal of the rejections with respect to claims 1 and 15, and to the claims which depend therefrom.

Claim Rejections Based on 35 U.S.C. §103

Claims 1-6, 11-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agarwal et al (U.S. Patent No. 6,007,228) (Agarwal) and the Audio Codec '97 Component Specification, Revision 2.2 (AC97). Claims 7-10 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agarwal and AC97 in further view of Markow et al (U.S. Patent No. 6,359,994) (Markow). Applicant respectfully traverses these rejections on the grounds that the combination of references fails to teach all the limitations of any rejected claim, and therefore fails to present a *prima facie* case of obviousness.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach all limitations of the rejected claims. Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims.

Rejection of Claims Based on Agarwal and AC97

Claims 1-6, 11-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agarwal and the AC97. Applicant respectfully traverses this rejection on the grounds that the combination of references fails to teach all limitations, and therefore fails to present a *prima facie* case of obviousness.

Claim 1 includes: "a processor; memory coupled to the processor; glue logic coupled to the processor for facilitating connection of the processor to other devices; an audio coder and decoder coupled to the glue logic and including a unidirectional Sony-Philips Digital Interface (S/PDIF) digital audio output; a first multi-pin docking connector comprising a first single audio pin coupled to the unidirectional S/PDIF digital audio output; a docking station comprising a second multi-pin docking connector comprising a second single audio pin, wherein the second single audio pin is coupled to the first single audio pin; and a digital audio receiver to convert S/PDIF digital audio to analog audio, wherein the digital audio receiver is located at the docking station and coupled to the second single audio pin."

Agarwal does not teach a docking interface with two docking connectors each having a single audio pin. Agarwal teaches a docking interface having two docking connectors each requiring 5 audio pins to transmit audio signals. According to Agarwal, a serial output is "transmitted in the 5-wire external audio link 58" which connects "master mixer 54 to external controller 86" through the docking interface. Fig. 4; col. 6, ll. 48-49; col. 11, ll. 23-26; col. 9, ll. 65-66.

AC97 teaches nothing to overcome the deficiencies of Agarwal. For at least this reason, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met with respect to claim 1. Independent claims 11 and 21 are patentable at least for similar reasons as described for representative claim 1. As a result, the USPTO's burden of

factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claims 1, 11 and 21, and to the claims which depend therefrom.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because 1) the combination of references fails to teach all limitations of the rejected claims, 2) AC97 teaches away from the claimed subject matter, and 3) the references are not properly combinable as their intended functions would be destroyed. Therefore, it is impossible to render the subject matter of the claims as a whole obvious, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

As discussed above, neither Agarwal nor AC97 teach the claim limitation "a first multi-pin docking connector comprising a first single audio pin coupled to the unidirectional S/PDIF digital audio output; a docking station comprising a second multi-pin docking connector comprising a second single audio pin, wherein the second single audio pin is coupled to the first single audio pin." Thus, none of these references can provide any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103(a) rejection of the claims.

Additionally, AC97 teaches away from the claimed subject matter. Although AC97 acknowledges that S/PDIF is an established consumer electronics digital audio interface that is supported by AC97, it states that "Intel does not advocate the use of S/PDIF out for the attachment of speakers." p. 64. AC97 further goes on to say that "S/PDIF is not as user friendly as USB" because it "is non-PnP, unidirectional, low bandwidth, and carries data only (i.e. you can't tell if S/PDIF equipment is connected or operational, nor can you control it). S/PDIF is also complicated by incompatible physical connectors." p. 64. Accordingly, it would not have been obvious to incorporate an S/PDIF output into a docking station and there is

simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

Furthermore, the references are not properly combinable as their intended functions would be destroyed. Claim 1 includes, "an audio coder and decoder coupled to the glue logic and including a unidirectional Sony-Philips Digital Interface (S/PDIF) digital audio output." Agarwal does not teach a unidirectional S/PDIF digital audio output. The digital audio connections in Agarwal are bidirectional. Fig. 4. Therefore, audio signals must go through a master mixer in order to be sent and received. Fig. 4. According to Agarwal, "[r]ather than communicate directly with each other, the internal and external audio controllers must send and receive digital audio signals through master mixer 54," col. 6, ll. 61-63. By using the master mixer to route signals, Agarwal requires additional hardware and software than what is currently claimed. The master mixer is hardware, and it requires software to properly route signals.

AC97 does teach an S/PDIF output that is supported by AC97. However, Agarwal and AC97 are not properly combinable because including the S/PDIF of AC97 in the docking station setup of Agarwal would destroy the intended function of the invention in Agarwal. The master mixer of Agarwal "has bidirectional connections to internal audio link 56 and external audio link 58" and is used to "combine both the external audio from the external microphone, CD, or line input with the FM synthesized music from the internal audio system. The combined audio from master mixer 54 can then be sent back out to external audio controller 86 over external audio link 58 for playback on the external speakers." col. 10, ll. 43-45; col. 12, ll. 42-47. If Agarwal used unidirectional connections, it could not receive external audio over audio link 58, mix it, and then send it back out to be played on the external speakers over audio link 58. For at least these reasons, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to claim 1. Independent claims 11 and 21 are patentable at least for similar reasons as described for representative claim 1. Accordingly, Applicant respectfully requests withdrawal of this rejection with respect to claims 1, 11 and 21, and to the claims which depend therefrom.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent

some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

Rejection of Claims Based on Agarwal, AC97 and Markow

Claims 7-10 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agarwal and AC97 in further view of Markow. Applicant respectfully traverses this rejection on the grounds that the combination of references fails to teach all limitations of the rejected claims, and therefore fails to present a *prima facie* case of obviousness.

As discussed above, Agarwal and AC97 fail to teach all limitations of claims 1 and 11, from which claims 7-10 and 18-20 depend. Markow teaches nothing to overcome the deficiencies noted for the combination of Agarwal and AC97. Applicant thus submits that the references are not properly combinable with respect to any rejected claim. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Therefore, independent claims 1, 11 and 21 and their respective dependent claims are submitted to be allowable.

In view of all of the above, the allowance of claims 1, 5-11 and 15-21 is respectfully requested.

The amended claims are supported by the original application.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


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